

REMARKS

In the Office Action mailed August 9, 2006, the Examiner rejected claims 32-52. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 32, 33, 38, 41, 42, 45 and 52 and have added new claims 53-55. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art.

I. Claim Rejections under 35 USC 112

Claims 32-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Without acquiescing this rejection, Applicants suggest that the currently amended claims overcome the rejection.

II. Specification Objections

The Office Action objected to the specification suggesting that the “exterior panel structure” lacked antecedent basis in the specification. Applicants have amended the specification above to overcome the objection.

III. Claim Rejections 35 USC 103

The Office action rejected claims 32-52 as being obvious over 1995 MY Chrysler JA publication (hereinafter simply referred to as Chrysler) in view of combinations of Wycech et al. (US 5575526), Ligon et al. (5358397), Hanley et al. (5266133), Fitzgerald et al. (US 2002/0074827) and Jansen et al. (US 5591386). Although Applicants have amended the claims, Applicants traverse the rejections with particularity in effort to expedite prosecution in case any similar rejections were to be considered by the USPTO as being applicable to the currently pending claims. Applicants traverse the rejections on the grounds that 1) the Office Action has failed to make a prima facie case of obviousness using these references; and 2) the asserted rejections do not provide a

proper motivation for the combination of references and are based upon impermissible hindsight. Applicants also provide additional reasoning for the patentability of the claims of the present application.

The MPEP 2143.03 reads that, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), wrote:

("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Claim 32

Claims 32-33, 35-38, 41-42, 45-47 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrysler in view of Wycech et al and Ligon et al. The Office Action suggests that, "it would have been obvious ... to automatically apply an EVDM [expandable vibration damping material] onto an exterior surface of a beam using a robotic device in the process of Chrysler in order to not only controllably and precisely extrude (in-line) an expandable resin to an automotive beam, but also enhance the production efficiency as well as reduce the production cost by obviating the need for fasteners and the need to separately manufacture EVDMs." Applicants contend that this motivation is inadequate as a matter of law.

In particular, the Office Action provides no specific reason within the prior art or the knowledge of the skilled artisan that would suggest that a door beam would be a suitable candidate for receiving the expandable material according to the teaching of Ligon et al. The Office Action does not provide any document or evidence of knowledge of the skilled artisan suggesting that application of expandable material according to Ligon et al. would be particularly suitable as a replacement for application according to Chrysler. The reasons provided are merely those imagined by the Examiner using Chrysler and Ligon et al. to piece the claims of the present application together using impermissible hindsight. Without an indication in the prior art or evidenced in the knowledge of the skilled artisan as the specific suitability of the application techniques of Ligon et al. to a door beam, the Office Action has failed to establish prima facie obviousness of claim 32 and its dependents and Applicants request that the rejections of these claims be withdrawn.

Claim 42, Claim 45 and its dependents and Claim 52

The failure of the Office Action to establish prima facie obviousness against the claims of the present application becomes even more poignant when the rejections of claim 42, 45 and its dependents and claim 52 are studied. The Office Action suggests, at page 5 thereof, that "a preference on whether to sell/ship a reinforcing beam with an extruded foamable material to another manufacturer/manufacturing line or use this beam in-house is taken to be well within the purview of choice in the art." However, this

statement is merely an unsupported conclusory statement that cannot properly be used alone to establish obviousness. This statement is advanced without any showing that transportation of such a beam is known in the prior art or the knowledge of the skilled artisan.

The Office Action provides no indication within the prior art or the knowledge of the skilled artisan that the creation of door reinforcement beam with expandable material applied according to Ligon et al. would be chosen as suitable for subsequent transportation as recited in claim 42, claim 45 and its dependents and claim 52. Moreover, the realities of such a choice are not straightforward and cannot be simply addressed by the conclusory statement of the Office Action. It has not been shown in the prior art or the knowledge of the skilled artisan that an expandable material applied according to Ligon et al. would be able to remain adhered to a door beam during transport and installation, which can subject the door beam and expandable material to undesirable contact and movements that tend to remove the expandable material from the beam. Moreover, such a showing is not of minor significance since door beam reinforcements can often be oily and have arcuate surfaces, which can hinder adhesion. Thus, the failure of the Office Action to provide any prior art or evidence of knowledge of the skilled artisan suggesting the type of transportation recited in claim 42, claim 45 and its dependents and claim 52 is a failure of the Office Action to establish prima facie obviousness and withdrawal of the rejections of those claims is respectfully requested.

Moreover, Applicants point out that this failure to establish prima facie obviousness becomes even more poignant when the references used to suggest obviousness are studied. In particular, the only reference used to suggest application of expandable material to a beam followed by assembly of that beam to a vehicle is Wycech and the Wycech reference employs an expandable material that is likely unsuitable for transport. In particular, the formula provided in column 5, lines 51-56 includes EPON 828, which is a tacky liquid epoxy resin and since EPON 828 is over half of the material, the material is most certainly tacky, which is the opposite of the

material recited in the claims of the present application. Such a tacky material would be unsuitable for transport as recited in the claims of the present application, particularly if such material is applied to a door reinforcement beam. Such material could easily sag during transport and, more importantly, could stick to other objects or individuals during transport and subsequent installation. Thus, Applicants contend that Wycech is an inappropriate reference for use in rejecting claim 42, claim 45 and its dependents and claim 52 and Applicants request withdrawal of the rejections of those claims.

Additional Considerations

In addition to the above, Applicants suggest that the method of forming the vibration damping system claimed in the present application provides desirable benefits. Specifically, application, and particularly extrusion, of the vibration damping material by automated process to directly bond the damping material to a door reinforcement provides a desirable level of initial adhesion to the reinforcement. This initial adhesion, in turn, allows the vibration damping material to expand and contact a door panel with less sag or “fall-out” as compared to, for example, the configuration of Chrysler.

Moreover, that initial level of adhesion allows for use of more desirable vibration damping materials such as those discussed in the present application. In particular, softer or more elastic materials can often provide greater damping properties relative to harder and less elastic materials such as those employed in Chrysler. However, such softer, more elastic materials often tend to exhibit higher degrees of sag during expansion. Advantageously and unexpectedly, the initial level of adhesion counteracts that tendency of the softer, more elastic materials to sag and allows for a vibration damping system in a door assuming of an automotive vehicle that assists the door assembly to provide a significantly high degree of desirable sound transmission loss (on the order of 35 decibels, 50 decibels or more).

Applicants contend that the ability to use the softer, more elastic materials and/or the counteraction of the tendency of such materials to sag as they expand to contact the door panel which is provided by the method of the claims of the present application is a

significant consideration that suggests the patentability of the claims of the present application. This is particularly the case where the end result is a door assembly providing such desirable sound transmission loss.

IV. New Claims

Applicants submit new claims 53-55 to address aspects of the present invention. Applicant believes claims 53-55 are patentable over the cited references.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

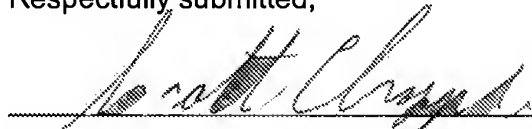
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

Dated: 8 December, 2006

A handwritten signature in dark ink, appearing to read "Scott Chapple", is written over a horizontal line.

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